

Jan 29 2002 11:52

From: FISH & NEAVE

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T-254 P.001/009 F-676

IN RE U.S. PATENT APPLICATION

Docket No. LT-5 Reissue

Application NUMBER: 08/794,374

Examiner: S. Riley  
GROUP: 2838

TRANSMITTAL COVER LETTER FOR FACSIMILE TRANSMISSION

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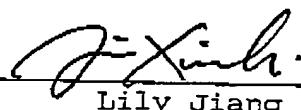
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REV. 9/01  
For Other Than A Small Entity

Docket No. LT-5 Reissue

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION FOR REISSUE OF U.S. PATENT 4,823,070

Date of Issue : April 18, 1989

Inventor : Carl T. Nelson

Title : SWITCHING VOLTAGE REGULATOR CIRCUIT

Assignee : Linear Technology Corporation

Serial No. : 08/794,374

Filing Date : December 10, 1996

Examiner : S. Riley

Group Art Unit : 2838

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January 29, 2002

Hon. Commissioner  
for Patents  
Washington, D.C. 20231

TRANSMITTAL LETTER

Sir:

Transmitted herewith: a Request For Continued Suspension Of Action to be filed in the above-identified patent application.

FEE FOR ADDITIONAL CLAIMS

A fee for additional claims is not required.  
 A fee for additional claims is required.

The additional fee has been calculated as shown below:

CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEES
TOTAL CLAIMS	-	* =	X \$ 18 =	\$
INDEPENDENT CLAIMS	-	** =	X \$ 84 =	\$
FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM			+ \$280 =	\$

\* If less than 20, insert 20.

TOTAL \$

\*\* If less than 3, insert 3.

- A check in the amount of \$ \_\_\_\_\_ in payment of the filing fee is transmitted herewith.
- The Director is hereby authorized to charge payment of any additional filing fees required under 37 C.F.R. § 1.16, in connection with the paper(s) transmitted herewith, or credit any overpayment of same, to deposit Account No. 06-1075. A duplicate copy of this transmittal letter is transmitted herewith.
- Please charge \$ \_\_\_\_\_ to Deposit Account No. 06-1075 in payment of the filing fee. A duplicate copy of this transmittal letter is transmitted herewith.

#### EXTENSION FEE

- The following extension is applicable to the Response filed herewith; [ ] \$110.00 extension fee for response within first month pursuant to 37 C.F.R. § 1.136(a); [ ] \$400.00 extension fee for response within second month pursuant to 37 C.F.R. § 1.136(a); [ ] \$920.00 extension fee for response within third month pursuant to 37 C.F.R. § 1.136(a); [ ] \$1,440.00 extension fee for response within fourth month pursuant to 37 C.F.R.

§ 1.136(a); \$1,960.00 within fifth month pursuant to  
37 C.F.R. § 1.136(a).

[ ] A check in the amount of [ ] \$110.00, [ ] \$400.00,  
[ ] \$920.00; [ ] \$1,440.00; [ ] \$1,960.00 in payment  
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[ ] \$920.00; [ ] \$1,440.00; [ ] \$1,960.00; extension  
fee to Deposit Account No. 06-1075. A duplicate  
copy of this transmittal letter is transmitted  
herewith.



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REV. 11/98  
For Other Than A Small Entity

Docket No. LT-5 Reissue

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
APPLICATION FOR REISSUE OF U.S. PATENT 4,823,070

Date of Issue : April 18, 1989  
Inventor : Carl T. Nelson  
Title : SWITCHING VOLTAGE REGULATOR CIRCUIT  
Assignee : Linear Technology Corporation  
Serial No. : 08/794,374 FAX COPY RECEIVED  
Filing Date : December 10, 1996 JAN 29 2002  
Examiner : S. Riley TECHNOLOGY CENTER 2800  
Group Art Unit : 2838

January 29, 2002

Hon. Assistant Commissioner  
for Patents  
Box Reissue  
Washington, D.C. 20231

REQUEST FOR CONTINUED SUSPENSION OF ACTION

Sir:

Action in the above-captioned reissue application has been suspended in view of concurrent litigation involving "on-sale" bar issues that overlap with issues in this reissue proceeding. A District Court judge decided these on-sale bar issues against reissue applicant Linear Technology Corporation ("LTC"). The District Court's judgment has since been reversed by a three-judge panel of the

Court of Appeals, but the appellee Micrel, Inc. has requested a re-hearing of the appeal by the entire Court of Appeals.

LTC submits this paper to advise the Office of the status of the concurrent litigation, and to request that the suspension of action in the reissue application be continued until the re-hearing proceedings relating to LTC's appeal in the concurrent litigation are completed.

This reissue application is directed to U.S. Patent 4,823,070 (the "'070 Patent"). As set forth in LTC's original request for suspension of the reissue proceedings, the invention disclosed in the '070 patent was incorporated into a five-terminal current-mode switching voltage regulator integrated circuit product sold under the designation of "LT-1070". (See ¶6 of the Reissue Declaration And Power of Attorney filed in the '649 reissue application.)

In addition to the invention of the '070 patent, LTC's LT-1070 product embodies subject matter claimed in U.S. Patent 4,775,741 (the "'741 patent"), entitled "Adaptive Transistor Drive Circuit." The '741 patent, like the '070 patent, is assigned to LTC, and both have a filing date of November 18, 1986.

In May 1994, LTC commenced a lawsuit against Micrel, Inc. ("Micrel") in the United States District Court for the Northern District of California, Case No. C94-1633 (now designated Linear Technology Corp. v. Micrel, Inc., C94-1633 MHP), alleging among other things that Micrel was infringing

the '741 patent. In the litigation, Micrel raised the defense that claims of LTC's '741 patent are invalid in view of the on-sale bar of 35 U.S.C. §102(b).

A trial on the on-sale bar defense raised by Micrel was conducted on April 7-10, 1998.

On August 20, 1999 the District Court entered judgment on Micrel's on-sale bar defense. The Court declared that U.S. Patent 4,775,741 is invalid under 35 U.S.C. §102(b), and dismissed LTC's action against Micrel.

LTC appealed the District Court's judgment that the '741 patent is invalid. After hearing oral argument on LTC's appeal in October 2001, a panel of the Court of Appeals for the Federal Circuit reversed the District Court's judgment holding the '741 patent invalid under the on-sale bar. The panel issued this decision on December 28, 2001.

On January 11, 2001, Micrel petitioned the Court of Appeals for the Federal Circuit for a re-hearing en banc of the appeal. Micrel seeks a re-hearing on the ground that the panel deciding LTC's appeal erroneously relied on the holding of another panel of the Court of Appeals in Group One, Ltd. v. Hallmark Cards, Inc., 254 F.3d 1041 (Fed. Cir. 2001). Micrel asks that the full Court of Appeals overrule the holding in Group One.

On January 15, 2001, the Court of Appeals requested that LTC respond to Micrel's petition by January 29, 2001.

LTC has filed a response, asking that the petition be denied.

The Court of Appeals has not acted on Micrel's petition.\*

Until Micrel's petition is acted on, the appeal remains pending. If the petition is granted, LTC's appeal will be re-argued before the full Court of Appeals at a date to be set by the court.

The on-sale bar issue being addressed in the ongoing appeal presents a significant overlapping issue with the present reissue application. The invention of the '070 patent now in reissue is embodied in the same LTC LT-1070 product that was found by the District Court to be on-sale more than one year prior to November 18, 1986 - the common filing dates of the '070 and the '741 patents.

The appellate panel's decision to reverse the District Court's judgment does not terminate the litigation in view of Micrel's pending request that the appeal be re-heard en banc.

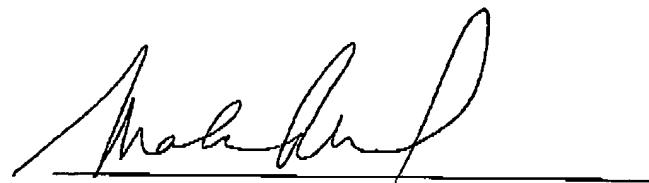
Accordingly, the overlapping issue is whether the reissue application should be rejected in view of the on-sale bar of 35 U.S.C. §102(b) based on the District Court's judgment. If the Court of Appeals declines Micrel's petition for re-hearing, or if the petition is granted and the full Court of Appeals decides like the panel to reverse the

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\* A third party has asked the Court of Appeals for permission to file a brief in support of Micrel's petition for re-hearing, also seeking to overrule Group One.

District Court's judgment that the '741 patent is invalid under the on-sale bar of 35 U.S.C. § 102(b), then the prosecution of the present reissue application should resume. In any event, given that the on-sale bar issues are still being litigated in the courts, it would be a waste of time and resources to continue the reissue proceeding at this time. Continued suspension of the reissue proceeding avoids duplicative effort of refiling the application if the District Court's invalidity holding is overturned.

In view of the continuation of the concurrent litigation at the appellate court level, and in order to avoid duplication of effort between the litigation and this reissue proceeding, applicant respectfully requests that the suspension of action in this reissue application be continued until termination of the litigation, including LTC's appeal of the judgment of the District Court and any further litigation resulting from the appellate court's holding.



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